

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

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U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RABINDRANATH DUTTA

Appeal No. 2004-1712
Application 09/583,346

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ON BRIEF

Before OWENS, LEVY and MacDONALD, *Administrative Patent Judges*.

OWENS, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal is from the final rejection of claims 2-8, 11, 12, 14-17, 20, 21, 23-26 and 28-30, which are all of the claims pending in the application.

THE INVENTION

The appellant claims a method, system and computer program product for displaying a data page on a portable device.

Claim 28, which claims the method, is illustrative:

28. A method for displaying data on a portable device having a display that is significantly larger in a first dimension than in a second dimension, said method comprising the steps of:

receiving a data page in the portable device;

analyzing the data page; and

automatically displaying the data page in either a first orientation or a second orientation within the display in response to the analysis of the data page.

THE REFERENCES

Wharton et al. (Wharton)	5,831,664	Nov. 3, 1998
Badger	5,973,664	Oct. 26, 1999

THE REJECTIONS

The claims stand rejected as follows: claims 28, 29 and 30 under 35 U.S.C. § 112, first paragraph, enablement requirement; claims 2, 4-8, 11, 14-17, 20, 23-26 and 28-30 under 35 U.S.C. § 102(b) as being anticipated by Wharton; and claims 3, 12 and 21 under 35 U.S.C. § 103 as being obvious over Wharton in view of Badger.

OPINION

We reverse the aforementioned rejections.

Rejection under 35 U.S.C. § 112, first paragraph

The examiner argues that the appellant's analysis of the data page is a new or improved system/method and that, therefore, the appellant must provide mathematical or programming procedures for carrying out the analysis (answer, pages 4-5). The appellant argues (brief, page 5) that the analysis of the data page is enabled by the appellant's disclosure that "the device can automatically determine the best-fit orientation for the display. By examining the line-width of the text being received, the device will determine whether the wide or narrow orientation will be used as the default orientation for that set of text" (specification, page 7, lines 26-31).

Regarding enablement, a predecessor of our appellate reviewing court stated in *In re Marzocchi*, 439 F.2d 220, 223-24, 169 USPQ 367, 369-70 (CCPA 1971):

[A] specification disclosure which contains a teaching of the manner and process of making and using the invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented *must* be taken as in compliance with the enabling requirement of the first paragraph of § 112 unless there is reason to doubt the objective truth of the statements contained therein which must be relied on for enabling support. . . .

. . . it is incumbent upon the Patent Office, whenever a rejection on this basis is made, to explain why it doubts the truth or accuracy of any statement in a supporting disclosure and to back up assertions of its own with acceptable evidence or reasoning which is inconsistent with the contested statement. Otherwise, there would be no need for the applicant to go to the trouble and expense of supporting his presumptively accurate disclosure.

The examiner has not provided the required evidence or reasoning to back up his assertion that one of ordinary skill in the art would have needed a disclosure of mathematical or programming procedures to be able to carry out the appellant's claimed invention. We therefore reverse the rejection under 35 U.S.C. § 112, first paragraph.

Rejection under 35 U.S.C. § 102(b)

Each of the appellant's independent claims requires analyzing a data page and, in response to that analysis, automatically displaying the data page in either a first orientation or a second orientation within the display.

Wharton discloses a system comprising at least one mobile interface device, such as a personal digital assistant [PDA], that transmits signals to a set-top transceiver device having a processor and data storage capability (col. 3, lines 28-31 and 64-66). The set-top transceiver device transmits a

corresponding signal to a server and then receives signals from the server and transmits synchronized signals to the mobile interface device and an interactive terminal such as a television receiver or a computer terminal (abstract; col. 3, lines 34-37; col. 3, line 65 - col. 4, line 4).

The examiner argues that "the reference Wharton et al. disclose in col. 7, lines 21-24, that the PDA can be dynamically (meaning: automatically displaying the data page in either a first orientation or a second orientation) reconfigured to offer different options and buttons for controlling both the content of the information on the PDA as well as what is shown on the TV" (answer, pages 5-6). This portion of Wharton discloses that when a house location is selected on a PDA touch screen map (figure 9, item 3a), a house information screen (figure 9, item 3b) appears having options and buttons not appearing on the map screen. This portion of Wharton does not disclose that a data page is automatically displayed in either a first orientation or a second orientation within the display in response to an analysis of the data page.

The examiner states that "Examiner requests the board to consider that the reference Wharton et al. display data page shown on the TV (with much larger display area and different format data) on the PDA (portable device with small display area) device" (answer, page 6). The appellant's claims require that the data page is displayed in either a first orientation or a second orientation within the display of a portable device. That claim requirement is not met by a disclosure of one display on a TV and another display on a PDA.

The examiner argues that "the concept of the claim invention is inherently shown by Wharton et al.'s invention" (answer, page 6). The examiner, however, provides no explanation in support of this argument.

For the above reasons we find that the examiner has not carried the burden of establishing a *prima facie* case of anticipation of the appellant's claimed invention. Accordingly, we reverse the rejection under 35 U.S.C. § 102(b).

Rejection under 35 U.S.C. § 103

Badger discloses a method, system and software product for presenting an image on a computer display such that the image conforms in orientation to one of a plurality of selectable

orientations with respect to the computer display (col. 2, lines 5-7; col. 2, line 64 - col. 3, line 7).

The examiner relies upon Badger only for a disclosure of first and second display orientations that differ from each other by a 90° rotation, and not for any disclosure that remedies the above-discussed deficiency in Wharton as to the independent claims (answer, page 13). Hence, we reverse the rejection under 35 U.S.C. § 103.

DECISION

The rejections of claims 28, 29 and 30 under 35 U.S.C. § 112, first paragraph, enablement requirement, claims 2, 4-8, 11, 14-17, 20, 23-26 and 28-30 under 35 U.S.C. § 102(b) over Wharton, and claims 3, 12 and 21 under 35 U.S.C. § 103 over Wharton in view of Badger, are reversed.

REVERSED

<i>Terry J. Owens</i>)
TERRY J. OWENS)
Administrative Patent Judge)
<i>Stuart S. Levy</i>)
STUART S. LEVY)
Administrative Patent Judge)
<i>Allen R. MacDonald</i>)
ALLEN R. MacDONALD)
Administrative Patent Judge)

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